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(Our File No. 23,116)

In the Application of:

**EDSAL MANUFACTURING COMPANY**

Application No. 10/715,000

For: **Cargo Rack**

Filing Date: November 17, 2003

**Art Unit 3634**  
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Patent Examiner

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**Request for Reconsideration of Restriction Requirement and Express Election**

This Response is in regard to the office action dated August 11<sup>th</sup>, 2005 for a restriction requirement. Applicant respectfully traverses the restriction requirement and makes an express election, as required by 37 CFR 1.143. Please charge any additional payments and credit overpayments to Deposit Account No. 01-1154.

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**1. Comments Regarding Inventions I and II related as subcombinations**

**a. Invention I and Invention II are not related as subcombinations**

A combination is an organization of which a subcombination or element is a part. MPEP § 806.05(a). Invention I is a combination because it is an organization of the elements comprising recessed structural beams with ribs, vertical posts, and shelf members, as set forth in claim 1. Invention II is a subcombination of Invention I, because Invention II also comprises the recessed structural beam with ribs, which is an element of Invention I. Therefore, Invention I and Invention II are not related as subcombinations; but rather, Invention I is a combination and Invention II is a subcombination.

Consequently, in order to establish that the combination and subcombination inventions are distinct, two-way distinctiveness must be demonstrated. MPEP § 806.05(c). Inventions are distinct if it can be shown that a combination as claimed does not require the particulars of the subcombination as claimed for patentability to show novelty and nonobviousness. MPEP § 806.05(c). The combination represented by Invention I requires the particulars of the subcombination represented by Invention II as claimed for patentability, because the recessed structural beams in Invention I and Invention II include a recessed flange. Therefore, Invention I and Invention II are not distinct.

Additionally, where the relationship between claims is such that the separately claimed subcombination constitutes the essential distinguishing feature of the combination as claimed, *the inventions are not distinct and a requirement for restriction must not be made*. MPEP § 806.05(c). Invention II is a separately claimed subcombination that is an essential distinguishing feature of Invention I, because without the recessed structural beams, the framework of Invention I could not be used for storage. If the framework of Invention I did not have the recessed

structural beams, the shelving members could not be horizontally positioned in the framework, and the framework would not be able to store materials on top of the shelving members.

**b. Invention II has no utility without the vertical posts**

The separate utility which the examiner has cited for Invention II cannot be accomplished without the vertical posts. The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination or by itself. MPEP § 806.05(d). The examiner has not shown by way of example how Invention II can be used without vertical posts. Invention II is for use with a storage unit with vertical posts. Without vertical posts, the recessed structural beam would not be able to accomplish a stationary vertical position and have a recessed flange in which to place the horizontal shelving member. Consequently, Invention II does not have utility other than in the disclosed combination or by itself, and Inventions I and II are not distinct.

**2. Comments Regarding Inventions I and III related as subcombinations**

**a. Invention I and Invention III are not related as subcombinations**

A combination is an organization of which a subcombination or element is a part. MPEP § 806.05(a). Invention I is a combination, because it is an organization of the elements comprising recessed structural beams, vertical posts, and shelf members, as shown in claim 10. Invention III is a subcombination of Invention I, because Invention III also comprises the recessed structural beam, which is an element of Invention I. Therefore, Invention I and Invention III are not related as subcombinations; but rather, Invention I is a combination and Invention III is a subcombination.

Consequently, in order to establish that the combination and subcombinations inventions are distinct, two-way distinctiveness must be demonstrated. MPEP § 806.05(c). Inventions are distinct if it can be shown that a combination as claimed does not require the particulars of the subcombination as claimed for patentability to show novelty and nonobviousness. MPEP § 806.05(c). The combination represented by Invention I requires the particulars of the subcombination represented by Invention III as claimed for patentability because the recessed structural beams in Invention I and Invention III include a recessed flange. Therefore, Invention I and Invention III are not distinct.

Additionally, where the relationship between claims is such that the separately claimed subcombination constitutes the essential distinguishing feature of the combination as claimed, *the inventions are not distinct and a requirement for restriction must not be made.* MPEP § 806.05(c). Invention III is a separately claimed subcombination that is an essential distinguishing feature of Invention I, because without the recessed structural beams, the framework of Invention I could not be used for storage. If the framework of Invention I did not have the recessed structural beams, the shelving members could not be horizontally positioned in the framework, and the framework would not be able to store materials on top of the shelving members.

b. Invention III has no utility without the vertical posts

The separate utility which the examiner has cited for Invention III cannot be accomplished without the vertical posts. The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination or by itself. MPEP § 806.05(d). The examiner has not shown by way of example how Invention III can be used without vertical posts. Invention III is for use with a storage unit with vertical posts. Without

the vertical posts, the recessed structural beam would not be able to accomplish a stationary vertical position and have a perpendicular recessed flange in which to place the horizontal shelving member. Consequently, Invention III does not have utility other than in the disclosed combination or by itself, and Inventions I and III are not distinct.

### **3. Comments Regarding Inventions I and IV related as subcombinations**

#### **a. Invention I and Invention IV are not related as subcombinations**

A combination is an organization of which a subcombination or element is a part. MPEP § 806.05(a). Invention I is a combination, because it is an organization of the elements comprising standard structural beams with ribs, vertical posts, and shelf members, as set forth in claim 18. Invention IV is a subcombination of Invention I, because Invention IV also comprises standard structural beams with ribs, which is an element of Invention I. Therefore, Invention I and Invention IV are not related as subcombinations; but rather, Invention I is a combination and Invention IV is a subcombination.

Consequently, in order to establish that the combination and subcombinations inventions are distinct, two-way distinctiveness must be demonstrated. MPEP § 806.05(c). Inventions are distinct if it can be shown that a combination as claimed does not require the particulars of the subcombination as claimed for patentability to show novelty and nonobviousness. MPEP § 806.05(c). The combination represented by Invention I requires the particulars of the subcombination represented by Invention IV as claimed for patentability because the standard structural beams in Invention I and Invention IV include an angled return flange. Therefore, Invention I and Invention IV are not distinct.

Additionally, where the relationship between claims is such that the separately claimed subcombination constitutes the essential distinguishing feature of the combination as claimed,

*the inventions are not distinct and a requirement for restriction must not be made.* MPEP § 806.05(c). Invention IV is a separately claimed subcombination that is an essential distinguishing feature of Invention I, because without the standard structural beams, the framework of Invention I could not be used for storage. If the framework of Invention I did not have the standard structural beams, the shelving members could not be horizontally positioned in the framework, and the framework would not be able to store materials on top of the shelving members.

b. Invention IV has no utility without the vertical posts

The separate utility which the examiner has cited for Invention IV cannot be accomplished without the vertical posts. The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination or by itself. MPEP § 806.05(d). The examiner has not shown by way of example how Invention IV can be used without vertical posts. Invention IV is for use with a storage unit with vertical posts. Without the vertical posts, the standard structural beam would not be able to accomplish a stationary vertical position and have an angled flange in which to place the horizontal shelving member. Consequently, Invention IV does not have utility other than in the disclosed combination or by itself, and Inventions I and IV are not distinct.

4. Comments Regarding Inventions II and III related as subcombinations

a. Invention II and Invention III have not been disclosed as usable together in a single combination

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other. MPEP § 806.05(d). Invention II is a subcombination because it comprises the recessed

structural beam of Invention I. Likewise, Invention III is a subcombination because it comprises the recessed structural beam of Invention I. Invention II and Invention III are not usable together in a single combination, nor is there any evidence in the disclosure indicating that Invention II and Invention III are usable together in a single combination.

b. Invention III does not have a separate utility

Invention II and Invention III share the same utility, which is to support the shelf member. The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. MPEP § 806.05(d). The Examiner has not shown by way of example that Invention III has a separate utility. Furthermore, Invention II and Invention III share the same utility of supporting the shelf member, regardless of the rib's ability to provide more rigidity. Therefore, Invention II and Invention III are not distinct.

**5. Comments Regarding Inventions II and IV related as subcombinations**

a. Invention II and Invention IV have not been disclosed as usable together in a single combination

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other. MPEP § 806.05(d). Invention II is a subcombination because it comprises the recessed structural beam of Invention I. Likewise, Invention IV is a subcombination because it comprises the standard structural beam of Invention I. Invention II and Invention IV are not usable together in a single combination, nor is there any evidence in the disclosure indicating that Invention II and Invention IV are usable together in a single combination.

b. Invention IV does not have a separate utility

Invention II and Invention IV share the same utility, which is to support the shelf member. The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. MPEP § 806.05(d). The Examiner has not shown by way of example that Invention IV has a separate utility. Furthermore, Invention II and Invention IV share the same utility of supporting the shelf member, regardless of the horizontal return flange, because shelf members are supported on the top flange. Therefore, Invention II and Invention IV are not distinct.

6. Comments Regarding Inventions III and IV related as subcombinations

a. Invention III and Invention IV have not been disclosed as usable together in a single combination

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other. MPEP § 806.05(d). Invention III is a subcombination because it comprises the recessed structural beam of Invention I. Likewise, Invention IV is a subcombination because it comprises the standard structural beam of Invention I. Invention III and Invention IV are not usable together in a single combination, nor is there any evidence in the disclosure indicating that Invention III and Invention IV are usable together in a single combination.

b. Invention IV does not have a separate utility

Invention III and Invention IV share the same utility, which is to support the shelf member. The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. MPEP § 806.05(d). The Examiner has not shown by way of example that Invention IV has a separate utility. Furthermore, Invention IV does not even



include a recessed flange at the top of the structural beam, but rather a standard angled flange at the top of the structural beam (see claim 27). And if Invention IV did not have a standard angled flange at the top of the structural beam, then Invention IV would have not any utility, because the shelving member could not be supported. Consequently, Invention III and Invention IV share the same utility, and Invention III and Invention IV are not distinct.

#### **7. Rebuttal of Separate status by Different Classifications**

The fact that some inventions are classified by the USPTO in separate classes does not of itself warrant the requirement of a restriction. *Ex parte Uhlig*, 1903 C.D. 300 (Comm'r). The examiner has only cited different subclasses of class 211 as evidence of acquiring separate status. Since some inventions classified by the USPTO into different classes do not warrant the requirement of a restriction, then the different subclasses cited by the Examiner also does not warrant the requirement of a restriction. There is no indication that the subclasses 187, 189, 192, and 191 are special subclasses.

Additionally, even if Inventions I-IV are distinct, the examiner must show by appropriate explanation a separate status in the art when they are classified together. MPEP § 808.02. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search. *Id.* The examiner has not cited any patents which are evidence of such separate status and that a separate field of search is required. To the contrary, the patent No. 5,749,481 cited in applicant's IDS indicates that the subclass 191 and 187 were allowable as a single invention under class 211.

Furthermore, the Examiner has not shown that the subcombinations represented by Inventions II-IV has acquired an independent status in the art, as evidenced by patents being granted for the subject-matter of such subcombinations represented by Inventions II-IV.

Furthermore, a separate examining division in the USPTO has not been set up for consideration of Inventions II-IV, and the subject matter has not been shown to be adapted for substantial, practical uses other than in the general combination of Invention I. Therefore, subcombinations represented by Inventions II-IV would be regarded as being so related to the general combination represented by Invention I as to entitle Inventions II-IV to be claimed in the same application.

#### **8. Express Election**

Applicant traverses Examiner's restriction requirements of Invention I-IV and makes an express provisional election of Invention I represented by claims 1-24 for prosecution, as required by 37 CFR 1.143. Applicant further preserves the right to file a divisional application on non-elected claims 25-27 under 35 USC § 121.

#### **9. Conclusion**

Applicant respectfully traverses the restriction requirement and makes an express election, as required by 37 CFR 1.143.

Date:

Aug 19, 2005

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